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WILMERHALLE/BOSTON		EXAMINER		
60 STATE STREET		OUELLETTE, JONATHAN P		
BOSTON, MA 02109		ART UNIT		PAPER NUMBER
		3629		
		NOTIFICATION DATE		DELIVERY MODE
		02/19/2010		ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/734,811	<b>Applicant(s)</b> BHAND ET AL.
	<b>Examiner</b> Jonathan Ouellette	<b>Art Unit</b> 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 November 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6,8 and 10-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-6, 8, and 10-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/88/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 7, 9, and 15-18 have been cancelled; therefore, Claims 1-6, 8, and 10-14 are currently pending in application 10/734,811.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
4. Independent Claims 1 and 6 disclose storing event information in a database and then matching the stored information with stored profile information to determine invitees to receive specific emails with a plurality of events.
5. However, the Examiner is unclear how the system/user would determine the when the matching step would take place. Is there a threshold of events to be saved in the database before the match is made? Is there a threshold of time (every minute, day, week, month) that takes place before the match is made?
6. If there is no threshold, then it is unclear to the Examiner why the event information would even have to be saved, and would not directly be matched to a user one received.

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-6, 8, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gal et al. (WO 01/52106 A2).**

9. As per **Independent Claim 1**, Gal discloses a computer-implemented method of selectively distributing invitations for a plurality of events (Abstract), the method comprising the steps of: electronically storing in an event information database event records (Figs. 1-2, Server 26; C3 L8-11, the user creates a message and provides profile information – the message would inherently be saved in order to do a query on members, the message could contain a plurality of message types – to include an event or plurality of events), wherein the event information stored in each of the plurality of events records includes one or more corresponding invitee selection criteria (C3 L8-15, profile information); electronically storing in a member information database (Figs. 2 and 4) member information for each of a plurality of members (C3 L8-15, database of recipients); for each event of the plurality of events, in a computer system comparing the stored event information obtained from the member information database (Figs. 1-4) and the stored member information to identify for each member among the plurality of members all events among the plurality of events that match the stored member information for that member (system uses profile information attached to

message/invitation information for matching recipients to the message/invitation, pg 3, - in the case all events would be the single message being matched); electronically storing match information about all of the identified matches, wherein for each of at least some of the members among the plurality of members the stored match information identifies multiple events among the plurality of events that were detected for that member (pgs.5-6, Fig.5, multiple invitations stored per user profile/key number); and based on the stored match information, generating and sending an electronic invitation message to the electronic mailbox of each member of the plurality of members for which matches are identified in the stored match information (C2 L11-13, C3 L8-15, C4 L5-10, C5 L6-12, C6 L7-13), wherein each electronic invitation message invites its corresponding recipient to the events for which matches were detected for that corresponding recipient (Invitations, Fig.4, C5 L26-27).

10. Gal fails to expressly disclose storing event information in a database and then matching the stored event information with stored profile information to determine invitees to receive specific emails with a plurality of events.

11. However, as indicated in the 112 rejection above, saving the event information would be unnecessary for matching the event information with system users, and the Examiner believes the invention disclosed by Gal to be an advancement on the instant invention.

12. Gal discloses matching the event information as received by the system with specific invitees, based on saved profile information (Figs.1-5, C5 L26-27), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included saving the received event information for matching at a later time – but the method/system disclosed by Gal would be a more efficient use of time and storage space. (See KSR [127 S

Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

13. Furthermore, the Applicant fails to disclose why saving the information in a database would be an advancement on the prior art.

14. Gal also fails to expressly disclose receiving an “e-mail” as described by the applicant, wherein each of the plurality of members has a corresponding electronic mailbox for receiving electronic communications for storage and later retrieval by that member.

15. However, Gal does disclose sending invitations which can be done by “e-mail” (pg.4 L8), and it would have been obvious to use a variety of available e-mail formats available at the time the invention was made to include an e-mail system that included an electronic mailbox for receiving electronic communications for storage and later retrieval by that member, for the purpose of providing customers with a wide variety of formats for receiving sent messages.

16. Furthermore, Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.

17. However, Gal does disclose combining event information by user/key number (pg.5, combined event information disclosed as possible information available), and Gal also discloses electronically sending invitation information to users (pg.4).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender,

by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

19. As per **independent Claim 6**, Gal discloses a computer-implemented method of selectively distributing invitations for a plurality of events (Abstract), the method comprising: electronically storing in an event information database (Figs. 1-2, Server 26 – database inherent to server) event information (C3 L8-11, the user creates a message and provides profile information – the message would inherently be saved in order to do a query on members; the message could contain a plurality of message types – to include an event or plurality of events – the type of message would be non-functional descriptive material), wherein the event information stored in each of the plurality of events records includes one or more corresponding invitee selection criteria (C3 L8-15, profile information); electronically storing in a member information database (Figs. 2 and 4) member information for each of a plurality of members (C3 L8-15, database of recipients), wherein the member information for each of the plurality of members includes one or more member preferences (C3 L8-15, C5 L6-12, C6 L7-13); for each event of the plurality of events, in a computer system comparing the stored event information obtained from the member information database (Figs. 1-4) and the stored member information to determine for each member among the plurality of members all events among the plurality of events to which that member should be invited (system uses profile information attached to message/invitation information for matching recipients to the message/invitation, pg 3, - in the case all events would be the single message being matched) based on (a) matches between the member information and

the at least one invitee selection criterion for each of the plurality of events and (b) matches between the event information and the at least one member preference for the respective members (C2 L11-13, C3 L8-15, C5 L6-12, C6 L7-13); electronically storing invitation information indicating which events among the plurality of events each of the plurality of members should receive an invitation to, wherein for each of at least some of the members among the plurality of members the stored invitation information identifies multiple events among the plurality of events that were detected for the member (pgs.5-6, Fig.5, multiple invitations stored per user profile/key number); and based in the stored invitation information, generating and sending an electronic invitation message to each member of the plurality of members identified in the stored invitation information for receiving an invitation, wherein each electronic invitation message invites its corresponding recipient to the events identified for that recipient in the invitation information (Fig.4, pg.5, using tables 98 and 100 - electronic message)

20. Gal fails to expressly disclose storing event information in a database and then matching the stored event information with stored profile information to determine invitees to receive specific emails with a plurality of events.

21. However, as indicated in the 112 rejection above, saving the event information would be unnecessary for matching the event information with system users, and the Examiner believes the invention disclosed by Gal to be an advancement on the instant invention.

22. Gal discloses matching the event information as received by the system with specific invitees, based on saved profile information (Figs.1-5, C5 L26-27), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included

saving the received event information for matching at a later time – but the method/system disclosed by Gal would be a more efficient use of time and storage space. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

23. Furthermore, the Applicant fails to disclose why saving the information in a database would be an advancement on the prior art.
24. Gal also fails to expressly disclose sending/generating/receiving an “e-mail” as described by the applicant, wherein each of the plurality of members has a corresponding electronic mailbox for receiving electronic communications for storage and later retrieval by that member.
25. However, Gal does disclose sending invitations which can be done by “e-mail” (pg.4 L8), and it would have been obvious to use a variety of available e-mail formats available at the time the invention was made to include an e-mail system that included an electronic mailbox for receiving electronic communications for storage and later retrieval by that member, for the purpose of providing customers with a wide variety of formats for receiving sent messages.
26. Furthermore, Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.
27. However, Gal does disclose combining event information by user/key number (pg.5, combined event information disclosed as possible information available), and Gal also discloses electronically sending invitation information to users (pg.4).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender, by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

29. As per Claim 2 and 11, Gal discloses wherein the one or more corresponding invitee selection criteria comprises an area of practice (Fig.4, Occupation).

30. As per Claim 3 and 12, Gal discloses wherein the one or more corresponding invitee selection criteria for each of the plurality of events are selected by a sponsor of the respective event (C3 L8-15, user creates message with profile).

31. As per Claim 4 and 13, Gal discloses wherein the one or more corresponding invitee selection criteria comprises an identifier that uniquely identifies an individual member (C5 L6-12, e-mail address).

32. As per Claim 5 and 14, Gal discloses wherein the one or more corresponding invitee selection criteria comprises a list of identifiers, each of which uniquely identifies an individual member (e-mail address, web page).

33. As per Claim 8, Gal discloses wherein, in the comparing step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match

between the event information for the given event and the member preference for the given member.

34. As per Claim 10, Gal discloses wherein, in the comparing step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match between the event information for the given event and the member preference for the given member.

*Response to Arguments*

35. Applicant's arguments filed 11/30/2009, with respect to Claims 1-6, 8, and 10-14, have been considered but are not persuasive. The rejection will remain as FINAL, based on the sited prior art.

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

37. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. The Applicant is directed to the clarified rejection above in regards to the submitted arguments.

***Conclusion***

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

41. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

February 18, 2010

/Jonathan Ouellette/

Primary Examiner, Art Unit 3629

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